transmitting and receiving means. Thus, according to the Examiner, it would have been obvious to dispose the detecting device of Yoshimi at a base station. Upon further consideration of the Examiner's reasoning, applicant remains of the position that the Examiner's rejection is improper.

The Examiner appears not to be aware of the law regarding a "teaching away" from a proposed combination of prior art references as an indicator of non-obviousness. In particular, a prior art reference should be considered as a whole, and portions arguing against or teaching away from the claimed invention must be considered. Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve, Inc., 796 F.2d 443, 230 USPQ 416 (Fed. Cir. 1986). A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be led in a direction divergent from the path that was taken by the applicant. Tec-Air, Inc. v. Denso Manufacturing Michigan Inc., 192 F.3d 1353, 52 USPQ2d 1294 (Fed. Cir. 1999); In re Gurley, 27 F.3d 551, 31 USPQ2d 1130 (Fed. Cir. 1994).

In this case, Yoshimi at col. 1, lines 61-65 states that in a conventional system, in order to check the state of interference waves on radio channels of the same frequency in different zones, the transmission of radio waves from the base station of the zone to be checked had to be stopped. Such a system used a dedicated measurement device (col. 1, lines 66-67).

However, at col. 2, lines 12-21, Yoshimi explains that in such conventional system the transmission of a radio wave cannot frequently be stopped while the system is in service, and as a result a long amount of time was required to measure field intensities from other base stations. Yoshimi thus teaches away from stopping base station radio wave transmission as a method of detecting interference waves, by proposing a method wherein a mobile station measures the field intensity and quality of a downlink radio wave from a base station and reports the measured results back to the base station at regular intervals.

The Examiner states that he is not relying on the invention of Yoshimi, but rather is relying only on the discussion of Yoshimi relating to the conventional system, as purported "evidence that there exists a teaching of stopping transmission of radio signal for the purpose of detecting an interference signal." The Examiner's position would be correct if the Examiner were relying on Yoshimi as an anticipatory reference under 35 U.S.C. § 102, for in that case the concept of "teaching away" does not apply since no modification of the prior art would be required to arrive at the claimed invention. See Celeritas Technologies, Ltd. v. Rockwell, 150 F.3d 1354, 47 USPQ2d 1516 (Fed. Cir. 1998).

However, in this case the Examiner is not relying on Yoshimi under § 102, but instead proposes a combination of prior art references under an obviousness theory pursuant to 35 U.S.C. § 103. That is, the Examiner proposes to use the disclosure of Yoshimi as

a teaching regarding the stopping of base station transmission in the proposed modification of the prior art to supposedly arrive at the claimed invention. In such case, the prior art reference must be considered as a whole, and portions arguing against or teaching away from the claimed invention must be considered. Bausch & Lomb, supra.

In the present case, Yoshimi teaches that a mobile station is to make measurements of the quality of a downlink radio wave from a base station and periodically report the results back to the base station, to eliminate the necessity of stopping base station transmission for the measurement to be taken by a dedicated measurement device as in the conventional system. Thus, it would not be obvious from Yoshimi to modify the prior art of Fig. 11 to have a base station receive an interference radio wave during a time that transmission of a radio signal by the base station is stopped, as alleged by the Examiner.

Further, while the Examiner alleges that Fig. 11 would be used to modify Yoshimi, it is not apparent how Yoshimi would be thus modified since the entire basis of the Yoshimi disclosure is to use a mobile station to measure interference waves.

The Examiner's assertion that the feature of detecting interference waves on the downlink channel from the base station to the mobile station is not present in the claims is incorrect. Claim 1 sets forth controlling means for causing the transmitting means (which transmits base station data as a radio signal to a

mobile station) to stop transmitting the radio signal and to enable the receiving means to receive the interference wave signal. Thus, it is apparent that the interference signal so received is an interference signal from another base station. If the interference signal were a signal from a mobile station there would be no need to stop transmission of the radio signal from the base station to measure it.

In any event, the Examiner's assertion is irrelevant to the determination of the obviousness of combining Yoshimi with the prior art of Fig. 11 as proposed in the Office action. The issue of obviousness is independent from what is recited in the claims of a patent application. Whether or not it would be obvious to combine references or to modify one reference in view of another depends upon the teachings of the references and the level of ordinary skill in the art, and does not depend on the scope or breadth of the claims of a patent application.

In view of the foregoing, further and favorable reconsideration of this application, withdrawal of the outstanding grounds of rejection, and the issuance of a Notice of Allowance are earnestly solicited.

Please charge any fee or credit any overpayment pursuant to 37 CFR 1.16 or 1.17 to Deposit Account No. 02-2135.

Respectfully submitted,

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